

REMARKS

Claims 1-29 are pending in the application. Claims 1-29 have been rejected under 35 U.S.C. §103(a) as being deemed unpatentable over Applicants Admitted Prior Art (AAPA) in view of U.S. Patent No. 6,681,334 (Nakamura). Claim 28 has been rejected under 35 U.S.C. §112, second paragraph. Of the Claims, Claims 1, 9, 17 and 25 are independent. Claims have been amended to clarify the Applicants' invention. The application as amended and argued herein, is believed to overcome the rejections.

Regarding Rejection under 35 U.S.C. § 112, second paragraph

Claim 28 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention because "the chipset" lacks antecedent basis.

In response, applicants have amended claim 28 to recite "a chipset". Removal of the rejection under 35 U.S.C. § 112 and acceptance of claim 28 is respectfully requested.

Regarding Rejections under 35 U.S.C. § 102(e)

Claims 1-29 have been rejected under 35 U.S.C. §103(a) as being deemed unpatentable over Applicants Admitted Prior Art (AAPA) in view of U.S. Patent No. 6,681,334 (Nakamura).

Turning to the cited reference, Nakamura discusses a flexible disk drive in which there may be a flexible disk, that is, the flexible disk drive has removable media (flexible disk). The flexible disk drive includes a power saving signal that allows a computer coupled to the flexible disk drive to control the power consumed by the flexible disk drive. The flexible disk drive also includes an output signal that is indicative of whether a flexible disk is present in the flexible disk drive. The state of the output signal is monitored in conjunction with the state of the power saving signal to determine the state of a flexible disk in the flexible disk drive, for example, if a flexible disk was removed from the flexible disk drive and another flexible disk inserted in the flexible disk drive while the flexible disk drive was in power savings mode. (*See*, Abstract.)

To establish a prima facie case for obviousness under 35 U.S.C. 103(a), (1) there must be some suggestion or motivation to combine reference teachings; (2) there must be a reasonable

expectation of success; (3) the references when combined must teach or suggest all the claim limitations. For the reasons discussed below, it is respectfully submitted that the Office has not established a prima facie case under 35 U.S.C. 103(a) for claims 1-29 and that therefore, claims 1-29 are allowable.

The references when combined do not teach or suggest all the claim limitations

If none of the references teach a claimed element, as shown by addressing each reference individually, then the combination of the references does not contain the claimed element. Thus, even if the references are combined, all of the claim elements are not shown in the combination of the cited references.

Nakimura does not teach or suggest at least:

“if a change in configuration of a Redundant Array of Inexpensive Disks (RAID) system occurs during one mode of operation of a device coupled to the RAID system, storing, in the RAID system, data indicative, at least in part, of resulting configuration of the RAID system resulting after the change”

as claimed by the Applicants in Claim 1.

Nakimura merely discusses a flexible disk drive that can detect if a removable flexible disk which may be loaded in the flexible disk drive has been changed during the suspend state of a suspend/resume signal. (See Fig. 6.) There is no teaching or suggestion of at least “a change of configuration of a Redundant Array of Inexpensive Disks (RAID system” or “one mode of operation of a device coupled to the RAID system” as claimed by the Applicants. In contrast, the flexible disk drive coupled to a computer has multiple modes of operation which are controlled by the computer.

The Office fails to identify a suggestion or motivation to combine reference teachings

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990.)” (See MPEP 2143.01 III.)

The Office fails to identify a suggestion or motivation in the prior art for combining AAPA and Nakamura. The Office action merely states: “a routineer in the art would have been motivated to look for a teaching for the possible method of detecting a change while the device is operating in a suspend mode.” There must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. (See In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).)

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” In re Fritch, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992)(emphasis added). The Office action does not identify any evidence in the prior art indicating or in any way suggesting the desirability of the proposed modifications.

Furthermore, AAPA is directed to a RAID system, Nakamura is directed to a flexible disk drive in which a removable flexible disk may be installed. One of ordinary skill in the art RAID systems would not look to flexible disk drives for “storing, in the RAID system, data indicative, at least in part, of resulting configuration of the RAID system resulting after the change” as claimed by the Applicants in claim 1.

Therefore, separately or in combination, AAPA and Nakamura do not teach or suggest the Applicants’ claimed invention. Even if combined, the present invention as now claimed does not result as argued above.

Claims 1-8 are dependent claims that depend directly or indirectly on claim 1, which has been shown to be non-obvious over the cited art. Independent claims 9, 17 and 25 recite a like distinction and are thus non-obvious over the cited art. Claims 10-16 depend directly or indirectly on claim 9, claims 18-24 depend directly or indirectly on claim 17 and claims 25-29 depend directly or indirectly on claim 25 and are thus non-obvious over the cited references.

Accordingly, the present invention as now claimed is not believed to be made obvious from the cited references. Removal of the rejections under 35 U.S.C. § 103(a) and acceptance of claims 1-29 is respectfully requested.

CONCLUSION

In view of the foregoing, it is submitted that all claims (claims 1-29) are in condition of allowance. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the above-referenced application.

Please charge any shortages and credit any overcharges to Deposit Account Number 02-2666.

Respectfully submitted,

Date: 9/21/05

/Caroline M. Fleming/
Caroline M. Fleming
Reg. No. 45,566
Telephone No. (978) 553-7371